

IN THE TITLE OF THE INVENTION:

Please delete the Title of the Invention and substitute therefor:

-- CHECK VALVE ASSEMBLY --

Remarks

Presently, claims 1-14 and 16 are pending. Claims 1-13 stand allowed while claims 14 and 16 have been rejected under the equitable "Recapture" Doctrine which prevents a reissue applicant from obtaining subject matter surrendered in an attempt to obtain allowance of the original patent claims.

More particularly, and with reference now to the Office Action, the Examiner rejected claim 14 and indicated that its scope differs from that of originally filed claim 1 only in that, in claim 14, there are two clip connections, one of which comprises a springy tongue and is spaced from the surrounding wall, and the other of which comprises a springy tongue which is integral with the surrounding wall. The Examiner took the position that the change in scope recited in claim 14, even though narrower than the originally filed claim 1, is merely an obvious duplication of parts which is an unpatentable limitation. Accordingly, the Examiner was of the opinion that reissue claim 14 violates the recapture rule.

With regard to independent claim 16, the Examiner took the position that the claim adds no limitations to what was recited in originally filed claim 1 and, thus, violates the recapture rule as well.

Under the heading "Response to Arguments" in the Office Action, the Examiner stated that notwithstanding the fact that claim 16 recites additional limitations not

present in originally filed claim 1, applicant is prohibited from removing the limitation that caused claim 1 to be patented in this reissue application. The Examiner referred applicant to In re Clement at page 1166, that "[E]ven with the additional limitations, claims 50-52 are also broader than they are narrower in a manner directly pertinent to the subject matter that Clement surrendered during prosecution."

Applicant respectfully disagrees with the above, in particular, with the Examiner's arguments under "Response to Agreements". The recapture rule does not prohibit applicants from removing limitations that caused claims to be patented. Rather, the equitable rule against recapture prevents a reissue applicant from obtaining subject matter surrendered in an attempt to obtain allowance of the original patent claims.

Claim 14 is Allowable:

As explained by Examiners Joyce and Webster to applicant's representative during the personal interview conducted on May 13, the Patent Office is now following the decision laid down in In re Clement, 131 F.3d 1462, 45 USPQ2d 1161 (Fed. Cir. 1997) for guidance in determining whether reissue claims violate the Recapture Doctrine.

Applicant respectfully submits that according to In re Clement, "[t]he first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims."

Accordingly, applicant has prepared Table I below illustrating the differences between patent claim 1 and reissue claim 14. As can be seen below in the table, reissue claim 14 is broader than patent claim 1 in the "aspect" that the reissue claim 14 does not include the limitation of "wherein the inner frame (4) has a

surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9)".

Table I

| Patent Claim 1 | Reissue Claim 14 |
|--|--|
| 1. In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising: | 14. A check valve assembly adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising: |
| an outer housing to which | an outer housing having an open end and a surrounding wall; |
| an inner frame is connected with | an inner frame received in the open end; |
| a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3); and, | a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and, |
| the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve element (3) is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3); and, | first and second resilient clip connections joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle, |

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| wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9). | |
| | the first clip connection comprising a first springy tongue spaced from the surrounding wall, and |
| | the second clip connection comprising a second springy tongue integral with the surrounding wall. |

Further in accordance with In re Clement, applicant respectfully submits that the second step recited there in applying the recapture rule is "to determine whether the broader "aspects" of the reissue claims relate to surrendered subject matter." Also, in order to determine whether an applicant surrendered particular subject matter, one must turn to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

To the above end, applicant respectfully notes that during prosecution, original application claim 1 was canceled and original application claim 2 was rewritten into independent form to include all of the limitations of claim 2 and base claim 1 as filed. Accordingly, although applicant does not admit to any surrendered subject matter in the instant Amendment and Response, for the sake of argument, the only subject matter that could have been "surrendered" by applicant in the original prosecution could only have been the scope of independent claim 1 as

originally filed. Original application claim 1 is repeated below.

1. In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising an outer housing to which an inner frame is connected with a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve element (3) is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3).

As noted above, the second step in determining whether the recapture rule is applicable is to ascertain whether the broader aspects of the reissue claims relate to the surrendered subject matter. With regard to the rejected claims at hand, applicant respectfully submits that the broader aspects of the reissue claim 14, namely the absence of the limitation of "wherein the inner frame 4 has a surrounding rim 7 carrying rib members 8 spaced transversely with stays 9 extending therefrom and a surrounding frame 10 joining the stays 9" does not relate in any way to any subject matter that could fairly be considered to be "surrendered" during prosecution. As shown above, "surrendered" subject matter could only have been derived from the scope of canceled original patent claim 1 set out above. Since original application claim 1 did not include the rim, rib member and stay limitations, these broader aspects of reissue claim 14 do not relate to the "surrendered" scope of original application claim 1.

With further reference to In re Clement, once it is determined that an applicant has surrendered the subject matter of the canceled or amended claim, it is next appropriate to determine whether this surrendered subject matter has crept into the reissue claim. As noted in In re Clement, "[c]omparing the reissue claim with the canceled claim is one way to do this."

Accordingly, applicant respectfully presents Table II below which compares the reissue claim 14 with canceled original application claim 1. As can be seen from the Table II below, the "surrendered" subject matter of canceled original application claim 1 has not crept into the reissue claim 14 because the reissue claim 14 includes additional limitations above and beyond those presented in original application claim 1. In particular, the limitation that the outer housing, the inner frame, and the check valve element are joined by "first and second resilient clip connections" to hold the outer housing, inner frame, and check valve to a support of a motor vehicle. Further, the "first clip connection comprises a first springy tongue spaced from the surrounding wall, and the second clip connection comprises as second springy tongue integral with the surrounding wall".

For at least the above reason, applicant respectfully submits that the "surrendered" subject matter of original application claim 1 has not crept into the reissue claim 14.

Table II

| Original Application Claim 1 | Reissue Claim 14 |
|---|--|
| In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising: | 14. A check valve assembly adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising: |
| an outer housing to which | an outer housing having an open end and a surrounding wall; |
| an inner frame is connected with | an inner frame received in the open end; |
| a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3); and, | a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and, |
| the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3). | first and second resilient clip connections joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle. |
| | the first clip connection comprising a first springy tongue spaced from the surrounding wall, and |
| | the second clip connection comprising a second springy tongue integral with the surrounding wall. |

With yet further reference to In re Clement, the following principles are articulated to determine whether the recapture rule is applicable:

1. If the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim;
2. If it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible;
3. If the reissue claim is broader in some aspects, but narrower in others, then;
 - (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; and,
 - (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

In application of the above principles as set forth in In re Clement, it is important to ascertain "aspects germane to the prior art rejections" when the reissue claim is broader in some aspects than the canceled or amended claim but narrower in others.

To that end, applicant respectfully repeats the initial Examiner's Action in the original patent application for convenience of the Examiner here and with emphasis added to reinforce applicant's argument made below:

Claims 1, 3-5, and 7-11 are rejected under 35 U.S.C. § 103 as being unpatentable over either Feles, et al. or Frien in view of Mizusawa. Feles, et al. and Frien discloses the invention substantially as claimed. However, Feles, et al. and Frien do not disclose the resilient clip connection. Mizusawa shows a ventilator device for a vehicle. "When the side wall 17 is inserted through the mounting hole

27, the elastic pawl 23 and lock projection 24 of the side wall 17 engage with the edges of the hole, and the elastic pawl 23 is inwardly flexed as the side wall proceeds through the hole. Eventually, the bent rear end 27a of the door pillar defining the mounting hole engages with the elastic pawl 23 and lock projection 24, thus securing the ventilator device 15 in the mounting hole 27 of the door pillar P in co-operation with the rear end of the grille 18." (column 3, lines 34-48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the flange of Feles, et al. or the front part of Frien with the elastic pawl 23 in Mizusawa in order to provide ease in mounting.

According to the above, "aspects germane to the prior art rejection" are those that relate to flanges, pawls, and other clip connection mechanisms or devices that provide ease in mounting the subject check valve assembly onto an associated support of a motor vehicle. No other aspects were discussed in the record that could be considered germane to the patentability of the rejected original claims.

In the above respect, reissue claim 14 is narrower than both the original application claim 1 and patent claim 1 in that the clip connection is recited as including the limitation of "first and second resilient clip connections" joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle. Further, "the first clip connection comprises a first springy tongue spaced from surrounding wall, and the second clip connection comprises a second springy tongue integral with the surrounding wall." For this reason, applicant respectfully submits that reissue claim 14 is narrower than the canceled or amended claim in an aspect germane to the prior art rejection, namely, the aspect of the flange taught in the Feles, et al. prior art

reference and the elastic pawl taught in the Mizusawa reference cited by the Examiner in the original Office Action, as those teachings relate to the scope of original application claim 1.

Further, applicant respectfully submits that reissue claim 14 is broader than the canceled or amended claim only in an aspect unrelated and not germane to the rejection in that the reissue claim 14 does not include the limitation of "the inner frame 4 has a surrounding rim 7 carrying rib members 8 spaced transversely with stays 9 extending therefrom and a surrounding frame 10 joining the stays 9." The inner frame, rim and rib member limitations were not germane to the prior art rejection.

Therefore, for at least the above reasons, applicant respectfully submits that reissue claim 14 is allowable and does not violate the Recapture Doctrine.

Reissue Claim 16 is Allowable:

Once again, applicant respectfully submits that according to In re Clement, "[t]he first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims."

Accordingly, applicant has prepared Table III below illustrating the differences between patent claim 11 and reissue claim 16. As can be seen below in the table, reissue claim 16 is broader than patent claim 11 in the "aspect" that the reissue claim 16 does not include the limitation of "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)".

Table III

| Patent Claim 11 | Reissue Claim 16 |
|--|--|
| In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising: | A check valve assembly adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising: |
| an outer housing to which | an outer housing having an open end; |
| an inner frame is connected with | an inner frame received in the open end |
| a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through | a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and, |
| a resilient clip connection (6) carried on the outer housing (3) and, wherein the clip connection (6) comprises a springy tongue (22') | a resilient clip connection |
| formed separate from the outer housing (3), said springy tongue (22') being arranged on a locking element (30) | formed separate from the outer housing and carried on a locking element |
| which can be connected with the outer housing (3), and | which is connected with the outer housing |

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| said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3). | |
| | the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle. |

Further in accordance with In re Clement, applicant respectfully submits that the second step recited there in applying the recapture rule is "to determine whether the broader "aspects" of the reissue claims relate to surrendered subject matter." Also, in order to determine whether an applicant surrendered particular subject matter, one must turn to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

To the above end, applicant respectfully notes that during prosecution, original application claim 1 was canceled and original application claim 2 was rewritten into independent form to include all of the limitations of claim 2 and base claim 1 as filed. Accordingly, although applicant does not admit to any surrendered subject matter in the instant Amendment and Response, for the sake of argument, the only subject matter that could have been "surrendered" by applicant in the original prosecution could only have been the scope of independent claim 1 as originally filed. Original application claim 1 is repeated below.

1. In a check valve assembly in association with the ventilation system for the passenger space of a

motor vehicle, said assembly comprising an outer housing to which an inner frame is connected with a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve element (3) is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3).

As noted above, the second step in determining whether the recapture rule is applicable is to ascertain whether the broader aspects of the reissue claims relate to the surrendered subject matter. With regard to the rejected claims at hand, applicant respectfully submits that the broader aspects of the reissue claim 16, namely the absence of the limitation of "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)" does not relate in any way to any subject matter that could fairly be considered to be "surrendered" during prosecution. As shown above, "surrendered" subject matter could only have been derived from the scope of canceled original patent claim 1 set out above. Since original application claim 1 did not include the dovetail guide limitation, this broader aspect of reissue claim 16 does not relate to the "surrendered" scope of original application 1.

With further reference to In re Clement, once it is determined that an applicant has surrendered the subject matter of the canceled or amended claim, it is next appropriate to determine whether the surrendered subject matter has crept into the reissued claim. As

noted in In re Clement, "[c]omparing the reissue claim with the canceled claim is one way to do this."

Accordingly, applicant respectfully presents Table IV below which compares the reissue claim 16 with canceled original application claim 1. As can be seen from the Table IV below, the "surrendered" subject matter of canceled original application claim 1 has not crept into the reissue claim 16 because the reissue claim 16 includes additional limitations above and beyond those presented in original application claim 1. In particular, the limitation of the resilient clip connection being "formed separate from the outer housing and carried on a locking element which is connected with the outer housing, the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle."

For at least the above reason, applicant respectfully submits that the "surrendered" subject matter of original application claim 1 has not crept into the reissue claim 16.

Continuing on, applicant respectfully repeats here that based upon the initial Examiner's Action in the original patent application, "aspects germane to the prior art rejection" are those that relate to flanges, pawls, and other clip connection mechanisms or devices that provide ease in mounting the subject check valve assembly onto an associated support of a motor vehicle. No other aspects were discussed in the record that could be considered germane to the patentability of the rejected original claim.

In the above respect, as shown in Table IV below, reissue claim 16 is narrower than both the original application claim 1 and patent claim 11 in that the clip connection is recited as including the limitation of

"securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle." For at least this reason, applicant respectfully submits that reissue claim 16 is narrower than the canceled or amended claims in an aspect germane to the prior art rejection, namely, the aspect of the flange taught in the Feles, et al. prior art references and the elastic pawl taught in the Mizusawa reference cited by the Examiner in original Office Action, as those teachings relate to the scope of original application claim 1.

Further, applicant respectfully submits that reissue claim 16 is broader than the canceled or amended claim in an aspect unrelated and not germane to the rejection in that the reissue claim 16 does not include the limitation of "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)." The locking element being guided over a dovetail guide on the outer surface of the outer housing limitations were not germane to the prior art rejection.

Therefore, for at least the above reasons, applicant respectfully submits that reissue claim 16 is allowable and does not violate the recapture doctrine.

Table IV

| Original Application Claim 1 | Reissue Claim 16 |
|--|--|
| In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising: | A check valve assembly adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising: |
| an outer housing to which | an outer housing having an open end; |
| an inner frame is connected with | an inner frame received in the open end; |

| | |
|---|---|
| a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and | a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and, |
| the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3). | a resilient clip connection |
| | formed separate from the outer housing and carried on a locking element |
| | which is connected with the outer housing, |
| | the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle. |

CONCLUSION

In view of the above comments and arguments presented, applicant respectfully submits that reissue claims 14 and 16 are allowable under the Recapture Doctrine and in view of the references of record.

Accordingly, allowance of all claims and early notice to that effect is respectfully requested.

Respectfully submitted,

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